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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/154,646
Filing Date: September 17, 1998
Appellant(s): Cupp et al.

MAILED

JUL 31 2001

GROUP 1700

Thomas C. Basso
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed May 21, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

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(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because it goes beyond the scope of the claimed invention, which is the subject issue of appeal in this application.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The rejection of claims 1-3,6-7,13-15 and 18-24 under 35 USC § 102 (b) as anticipated by Gellman et al., is hereby withdrawn. *However*, it is noted that this rejection is dropped *solely* in view of the fact that this reference does not teach the limitation of "at least 2% by weight insoluble fiber" within the independent claims. This limitation was added via the amendment of October 20, 2000, and prompted the rejection of claims under 35 USC § 112, 1st paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. In other words, it is noted that absent this non-supported phrase within the claims, the Gellman et al. rejection would have been maintained.

(7) Grouping of Claims

The rejection of claims 1-20 and 24 stand or fall together, because appellant's brief does not include reasons in support of their statement that this grouping of claims does not stand or fall together. See 37 CFR 1.192(c)(7). Further, none of the dependent claims have been separately addressed.

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US PAT 5,407,661 Simone et al. April 1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

i. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,13,20 and 24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appellants' amendment of October 20, 2000, introduced new matter to the claims in the form of the phrase "at least 2% by weight insoluble fiber", which is not supported by the teachings of the original specification. It is noted that the specification and previous claims support language directed to "about 2% to about 15% by weight of insoluble fiber", but not any random amount above "at least 2%".

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ii. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Simone et al.

- Simone et al. disclose an edible pet food product comprising a matrix which comprises each of the following components:
 - a) cellulose (insoluble) fiber (col. 3),
 - b) gelatinized starch/carbohydrate (col. 3),
 - c) gelatinized/denatured protein (col. 3), and
 - d) a humectant such as glycerin at a concentration of about 1 to 15% (col. 5).
- Simone et al. disclose that a gelatinized starch is formed by the extrusion process (col. 3, lines 44-48), and the protein is denatured (gelatinized) by the same process at the same time (col. 3, lines 48-51).
- At col. 5, lines 65-68, Simone et al. teach that after extruding, "the chew particles are then allowed to cool and dry at a controlled temperature... to adjust the moisture level to about 10 to about 30% by weight" (underlining added) to form the final product. The "product as it leaves the extruder has a moisture content of about 10 to about 35% water by weight" (col. 7, line 19), and is "allowed to cool and dry" thereafter (col. 7, line 27). Therefore, this meets the instant claim limitation of "a moisture content of less than 10% by weight", since the referenced term "about 10%" encompasses amounts immediately

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above and below 10%, and since the product is even further "allowed to cool and dry" after exiting the extruder at a moisture content of "about 10%".

- Simone et al. disclose that the dried sections of this product were subdivided into pieces which were 2.75 inch in length, 1 inch wide, and .25 inch thick (col. 8, lines 14-15 and 22-24). This product was formulated for administration to a pet animal. The instantly-claimed method is anticipated by the reference, as the claims recite measurements of "at least 6 mm" (i.e. approximately 0.236 inches). Therefore, it would also follow that "the minimum distance from a center of gravity of the matrix to a surface of the matrix" would be "about 3 mm" (instant independent claims 13 and 24).
- Simone et al. also teach that the cellulosic fiber materials of the pet food were used in the range of about 20-50% by weight of the final product (i.e. cellulosic materials such as corn cob, etc., not necessarily actual cellulose levels of 20-50%). Both wheat and corn sources were also used as the starch. It is well-accepted that wheat generally contains 2.3- 5.6% total dietary fiber, with 1.7% of that being insoluble, including cellulose, and corn flour has 15% insoluble fiber, including cellulose (pg. 481, 484. Lorenz et al. "Handbook of Cereal Science and Technology", Dekker Press, 1991). Given these known constant amounts contained within wheat and corn, and given the amounts used as provided by the reference, this would have been expected to give the product a cellose, and/or other insoluble fiber, level within the range instantly claimed. For example, a pet food matrix made from the teachings of Simone et al. may contain 50% by weight of a corn (starch and fiber) source, which itself contains 15% insoluble fiber including cellulose. This would amount to approximately 7.8% (15% of 50%) insoluble fiber of the total weight of the pet food, and therefore fall within the claimed amounts of "at least 2%", and/or "about 2% to 15%".

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It is noted that because the rejected claims stand or fall together, the dependent claims have not been individually addressed herein, but have been previously, within the Office actions of record. Also, the recitation of the dried pet food as being in the form of "a cat food kibble" is given little patentable weight, as this does not impart any special features or patentable distinction to the claimed invention, especially given the subsequent description of the invention in the claims in simple terms of components, percentages, and/or measurements.

(11) Response to Argument

i. Rejection under 35 U.S.C. 112, first paragraph.

Appellants' argument is found at pages 9-12 of the Appeal Brief.

Appellants state that "it is not necessary that the application describe the claimed invention *ipsis verbis*" (in the identical words), but rather the basis for determining compliance with the statute is a matter of "whether one skilled in the art, reading the specification, would identify the subject matter of the new [amended] claims as being invented and disclosed by the patentees... as of the filing date of the application." Appellants state that original claims 1, 13 and 20 "required a dried pet food that included a matrix having an insoluble fiber with no upper limit", and attempt to construe this as an indication that "the claims as filed supported the use of any amount of insoluble fiber". Appellants point to page 3 of the specification, where it is disclosed that "the dried pet food conveniently contains about 2% to about 15% by weight of insoluble fiber", but then in the Brief, appellants add that "the terms 'preferably' and 'conveniently' clearly indicate that the figure of '15%' should not be construed as an upper limit for the content of insoluble fiber".

These arguments are not deemed persuasive, and it is believed that the rejection should be sustained, for the reasons of record and those set forth below.

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- Appellants attempt to disguise their lack of disclosure support, by implying that the Examiner has not "provided reasons why one of ... skill in the art would not consider the description sufficient." This is not persuasive, as the examiner has clearly and specifically provided factual evidence on the record, as well as prior Board- and Court-based rationale, for why the specification fails to support the claim language as amended on October 20, 2000. See specifically that provided in the "Attachment to Advisory Action", of paper number 13, and the further comments provided below.
- At no time did the Examiner require, nor imply, that the "identical words" be provided within the application, in order to provide support for the amended claims. Clearly, appellants, as well as the Examiner, are well aware of the statutes, published decisions and other information pertaining to this issue. However, regardless of appellants' recitation of various case law in the Brief, they have not provided a reasonable set of circumstances and information to specifically support their position that the October 20, 2000 amendment does not set forth what is commonly referred to as "new matter". While the case law cited by appellants is certainly valid in its own right, it is not applicable in the instant case, as this is not a simple matter of whether the person of skill in the art "would have understood the inventor to have been in possession of the claimed invention at the time of filing". This is because appellants' own disclosure would have led one skilled in the art away from the amended broad recitation of "at least 2% by weight insoluble fiber", since, apart from simply reciting "insoluble fiber" as a component, the only express teachings of numerical percentages and ranges within specification are stated to be "about 2% to about 15% by weight of insoluble fiber" -- with this being the broadest range or numbers provided.

An upper range was established in the specification, and is stated to be within the preferred amount. Therefore, one skilled in the art would simply *not* have been led to believe that the inventor was in possession at the time of filing, of the claimed invention of "at least

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2%"; or in other words, any random amount above "about 15%", up to and including 100% (which would be impossible according the remainder of the recitation of each independent claim, requiring other components to be present). Appellants' statement at the middle of page 11 of the Brief, referring to the description in the specification with regard to this range, that "the terms 'preferably' and 'conveniently' clearly indicate that the figure of '15%' should not be construed as an upper limit for the content of insoluble fiber", is misplaced, and finds no foundation in statute, case law, or even their own specification.

- At pages 11-12 of the Brief, appellants have stated that since they also disclosed "insoluble fiber" as a general component without percent limitations (i.e. as found in original claims 1, 13 and 20), this naturally encompasses "at least 2%", and that the claims as filed supported the use of any amount of insoluble fiber. This is not deemed persuasive.

Initially, it is noted that, whether the original claims were rejected or maintained for this original language, this is not relevant to the appealed claims and issues at hand.

Secondly, there is no support to select or define the specific point "2%" from the disclosed range of "about 2% to about 15%", in appellants' specification. The disclosure provides only two teachings with regard to this issue:

- a) the range of "about 2% to about 15%", which is, at least, somewhat clear as to a general amount of insoluble fiber; and
 - b) a general inclusion of "insoluble fiber" as a listed component, at page 2, lines 31-34.
- This provides no endpoints or amounts, above or below 2%, above or below 15%, or above or below any other percentage point.

Therefore, neither of these would have provided support for the specific lower endpoint of exactly "2%", such that the claims could be limited to only amounts above exactly 2%.

Appellants have not addressed this issue, beyond the statement that "the specification supports the limitation that the dried pet food of claims 1, 13, 20 and 24 can include about 2% by

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weight of insoluble fiber" (middle of page 11 of the Brief). This is not deemed persuasive, as of course, these claims do not contain this language of "about 2%", as purported by appellants, but rather the actual claim language of "2%".

Thirdly, there is no support for any and all percentages above the recited "about 15%" portion of the range in the specification. For example, in instant claim 1, other than the improperly-added insoluble fiber component percentage, there are no other percentages provided for the remaining components (note that the acceptable moisture level percentage recitation is not a specific individual component, *per se*, but may be inherently provided by any component(s) of the matrix, including the insoluble fiber). Thus, according to appellants' arguments that any amount of insoluble fiber "greater than 2%" may be included, the claimed pet food composition could encompass 80%, 90% or even 100% insoluble fiber. If this is the interpretation appellants contend, then the claims would still be improper, as it would be unclear as to how the remaining recited components could be present, as *required* by each of the rejected claims, if the composition was comprised of 100% insoluble fiber. If appellants wish to argue that the other components must certainly be present as claimed, and therefore 100% insoluble fiber would obviously not be encompassed by the claim(s), then it would be unclear as to what percentages would be necessary for each and every component, including the insoluble fiber, from the broadly-recited claim(s). It is further noted that these interpretations would also conflict with several dependent claims, as well. Simply put, the claims **cannot** encompass any amount of "at least 2% by weight of insoluble fiber", if only for the fact that this encompasses 100% insoluble fiber, which is not possible due to the remaining required components in the claims. Therefore, in summary, appellants' specification does not support the improperly-added phrase of "at least 2%". Appellants have not, however, argued or addressed either of these points, raised previously on the record.

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ii. Rejection under 35 U.S.C. 102(b) as being anticipated by Simone et al.

Appellants' argument is found at pages 12-17 of the Appeal Brief, and more specifically, at pages 16-17 with respect to Simone et al.

Appellants' position is based upon the statement that "the Patent Office has failed to establish a *prima facie* case of anticipation" (top of page 15). It is noted that, while technically not improper, a substantial portion of the remainder of the arguments provided in the Brief with respect to Simone et al. have not been previously presented in the prosecution of this application. Thus, the response in this Examiner's Answer does not constitute a new ground of rejection or new issues stemming therefrom, but rather it merely represents rebuttal to appellants' newly-presented arguments.

- Initially, at page 16 of the Brief, appellants state that "the clear emphasis of Simone [et al.] is on chew products and not food products." This is not deemed persuasive. To the contrary, Simone et al. directly teaches feeding the product to pets, specifically dogs, at mid-end col. 8. Further, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Appellants' next sentence at page 16 appears contradictory to that above, stating that "indeed, Simone discloses that its chew products were *fed to dogs to supplement a normal can diet*" (emphasis added). Appellants state that the claimed invention is for a meal, and encourages longer chewing, resulting in "tooth cleaning properties", as opposed to the product of the reference. This is not deemed persuasive, and the teachings of the reference have been misrepresented by appellant. Attention is drawn to the summary at col. 2 of Simone et al., which states that the "*edible* animal chew" (emphasis added) does not easily fracture, and therefore

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"increases the time that the product is retained in the animal's mouth cavity and in contact with its teeth." Column 8 of Simone et al. states that "dogs were *fed*" the product, and that "in observing the *eating* styles of the dogs" (emphasis added) with regard to eating either the disclosed product or canned dog food, "although the canned dog food ration tended to be gulped by the dogs, the spongy cellular chew product was chewed repeatedly before being swallowed. This chewing action increased the residence time that the chew product was in the dog's mouth thereby increasing the contact time with the teeth" (col. 8, lines 36-42). This increased residence time with the teeth of the pets as disclosed by Simone et al. resulted from the product being "significantly effective in reducing plaque, stain and tartar" (col. 9, lines 60-61), directly contradicting appellants' submitted interpretation. Finally, appellants' statement that the "chew products were fed to dogs to supplement a normal can diet" is incorrect, as can be clearly seen from the teachings of the reference, and the passage quoted directly above, where both canned food and the product of Simone et al. were separately presented to dogs, and each mode of consumption was separately noted. Regardless, this entire issue remains irrelevant to those of the instantly-claimed invention.

- Secondly, at pages 16-17 of the Brief, appellants state that "Simone [et al.] fails to disclose a moisture level below 10% by weight." Appellants refer to the specific examples and claims alone, in stating that Simone only discloses that "the moisture level is equal to or greater than 12% by weight."

This is not deemed persuasive for the reasons of record. Initially, it is not agreed that Simone teaches that the moisture content must be at a level of "equal to or greater than 12% by weight". This point has been repeatedly and specifically addressed in several previous Office actions, with specific factual statements based upon the teachings of the reference, and the principles of supporting case law.

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As stated previously above, Simone et al. teach that the moisture content of the final product can be dried "to adjust the moisture level to about 10 to about 30% by weight" (bottom of column 5). The "product as it leaves the extruder has a moisture content of about 10 to about 35% water by weight" (col. 7, line 19), and is subsequently "allowed to cool and dry" thereafter (col. 7, line 27). Therefore, this meets the instant claim limitation of "a moisture content of less than 10% by weight", since the referenced term "about 10%" encompasses amounts immediately above *and below* 10%, and since the product is even further "allowed to cool and dry" after exiting the extruder at a moisture content of "about 10%". Appellants' reference to the exemplified product percentages of Simone et al., does not in any way detract from the broader teachings *specifically recited within the same reference*, which provide a functional product that reads upon the instantly-claimed invention.

Appellants statements, with regard to the teachings of Simone et al. as "an intermediary product and not a final product" having "a moisture content of about 10% to about 35%" (page 17, lines 4-6 of the Brief), are imprecise, and misconstrue the reference with respect to the "final product" versus the extrudate at some point recently after extrusion. Appellants then rely upon a subsequent passage from col. 7 of Simone et al., which states that the extruded product is "allowed to cool and dry to a moisture content of about 12% to about 35% by weight water." This is not deemed persuasive for the reasons set forth above, and those set forth previously on the record. Even if appellants were correct in their interpretation of some unspecified differences between a disclosed intermediate and final product, this would be irrelevant to the issues at hand, as simply put, the reference teaches the claimed invention, regardless of at what "stage" the referenced product is found. Whether it subsequently dries for three seconds or three months, the reference product, as disclosed, anticipates the claimed invention. Further, even if "Simone clearly emphasize[d] a moisture content of 12% or more" (page 17, line 15 of the Brief), this "emphasis" would be irrelevant to, and would not detract from, the fact that the

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reference *specifically taught* a product -- whether labeled as intermediate, beginning, final, or otherwise -- with a moisture content of "about 10%", which reads upon amounts both more than, and "less than 10%". This point in fact is well-settled in case law, and there can be no ambiguity with respect to its interpretation or applicability to the claims and issues herein. Further, from appellants' explanation of the reference, it is unclear as to how a ("intermediary") product may leave the extruder having "a moisture content of about 10% to about 35%", as appellants admit as being taught by the reference, but yet be "allowed to cool and dry to a moisture content of about 12% to about 35% by weight water" to form a "final" product. More specifically on point, it does not make sense that a product may only leave the extruder having "a moisture content of about 10%" (the precise disclosed lower range amount), and yet dry "to a moisture content of about 12%" (another separately-disclosed lower range amount).

Appellants statement that Simone et al. "is clearly not enabling with respect to a moisture content of less than 10% by weight as required by the claimed invention", is confusing, inaccurate and unsubstantiated. While certainly a separate issue with its own separate standards, it is noted with great curiosity that appellants have certainly not applied the same rigid principles of interpretation to the teachings of their own specification, as addressed above under 35 U.S.C. 112, first paragraph, with regard to the insoluble fiber content of the instant claims. Appellants may not simply and arbitrarily choose which upper and lower limits, as taught by the reference, to interpret in their own light, such that each individual passage of a reference may or may not apply to their claims. It is improper to interpret the phrase "about 10%", with respect to the moisture content of the referenced product, as teaching *only above* 10%. As the corollary, it then must follow that it would be improper to interpret the referenced teaching of "about 10%" as not teaching moisture amounts *below* 10%, and thus reading upon a moisture level encompassed by the instant claims.

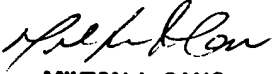
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- It is noted that *appellants do not contest any other point or issue* found within the stated teachings of the prior art of Simone et al., with respect to their applicability to the instant claims. It is noted that appellants did not acknowledge or address the factual and numerical data and logic set forth in the previous Office actions (for example, with regard to the insoluble fiber content taught by the reference), which has been repeated in the statement of the grounds of rejection section above, and which clearly established that the reference meets the instant claim limitations. Thus, the only two issues pertaining to Simone et al., are those addressed immediately above. It is therefore believed that the rejection should be sustained.

iii. In response to appellants' statements at the top of page 18 of the Brief, it is noted that the 35 USC § 102 (b) rejection of claim 24 over Hand et al., had been withdrawn. It was not maintained in the Final Office Action of January 02, 2001, due to appellants' amendments.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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July 27, 2001

Appeal Contended